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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,154	03/01/2005	Hiromi Wataya	P26700	6656
7055 7590 12/16/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
HAUTH, GALEN H				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
12/16/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

### Office Action Summary

**Application No.**

10/526,154

**Applicant(s)**

WATAYA, HIROMI

**Examiner**

GALEN HAUTH

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/309)  
Paper No(s)/Mail Date 07/25/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Acknowledgement is made to applicant's amendment of claims 1-4 as well as the addition of claims 5-12. No new matter has been added.

### *Claim Rejections - 35 USC § 102*

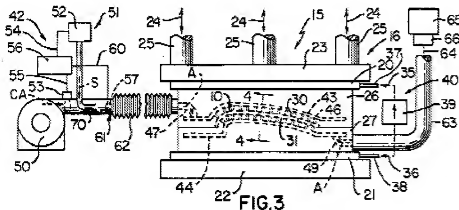
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3, 4, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (PN 4462785).

- a. With regards to claim 3, Smith teaches an apparatus comprising upper and lower molds (26, 27) with a plurality of hot air vents (46) extending through the molds at regular intervals and a connected hot air generator (60) and vacuum (65) to circulate the hot air through the mold as seen in the figure below.



b. Smith teaches that the molds are metal (claim 7). The limitation "apparatus for making pallets" is not considered a limitation of significance because the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states the purpose or intended use of the invention. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

*PitneyBowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). The limitation "to provide a pallet with recesses formed on its surface" in line 6 of claim 3 does not impart patentability to the claims because it provides the intended operation of the apparatus. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

- c. With regards to claims 4 and 12, as seen in the figure above, the hot air vent (43, 44) extends into the circumference of the mold.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-2, 5-7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wataya (JP 06-270938 A, Machine Translation of Record Used for Citation) in view of Smith (PN 4462785).

- a. With regards to claim 1, Wataya teaches a method for forming a pallet from vegetable fibers comprising a non-woven fabric of fibers that are impregnated with resin to provide a sheet like base material (¶ 0006) and pressing it in a metal mold (¶ 0009). Wataya does not teach that the mold includes a plurality of hot air vents, and passing hot air through the vents.

b. Smith teaches a method for molding a fibrous work piece of fibers and a dispersed adhesive by placing the work piece between two platens a passing hot air through the work piece while pressing (abstract). Smith teaches that the fibers may be natural fibers (col 3 ln 28). Smith teaches that the air is passed through a plurality of apertures on the surface of the platens (col 2 ln 3-14) that are dispersed over the entire confronting surface in a regular interval as seen in the figure below.

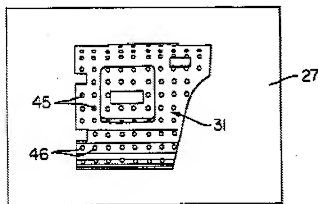


FIG. 5

c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the pallet of Wataya with the method of Smith, because both teach press forming resin impregnated fiber products and the method of Smith results in a highly efficient forming of a complete pad with great strength and structural integrity in a shorter cycle time (col 6 ln 55-65). While Wataya in view of Smith does not explicitly state that the airflow causes recesses formed by the air, the process of Wataya in view of Smith would inherently

produce recesses given similar work pieces and molding operations as the applicant.

**NOTE:** Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on “inherency” under 35 USC § 102, on prima facie obviousness” under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.”** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

- d. With regards to claims 2 and 5, Wataya teaches forming the fiber from coconuts (¶ 0012).
- e. With regards to claim 6, Wataya teaches that the plant fibers may be hempen vegetable fiber raw material (¶ 0012). Merriam-Webster’s Dictionary defines hemp as “a fiber (as jute) from a plant other than the true hemp; also: a plant yielding such fiber.” Therefore, hempen vegetable fiber raw material includes fibers from a jute plant.
- f. With regards to claim 7, Smith does not teach that the diameter of the through holes is 1 centimeter; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the diameter of the through holes to optimize the process by controlling the volume and velocity of air through the work piece through hole diameter including 1 centimeter.
- g. With regards to claim 9, Smith does not teach that there is one aperture per 5 square centimeters; however, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to change the spacing of the apertures to optimize the process by controlling the volume and velocity of air through the work piece through the density of hole outlets including one per 5 square centimeters.

h. With regards to claim 11, as seen in the figure above in the rejection of claim 3, the hot air vent (43, 44) of Smith extends into the circumference of the mold.

7. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (PN 4462785) as applied to claim 3 above

a. With regards to claim 8, Smith does not teach that the diameter of the through holes is 1 centimeter; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the diameter of the through holes to optimize the process by controlling the volume and velocity of air through the work piece through hole diameter including 1 centimeter.

b. With regards to claim 10, Smith does not teach that there is one aperture per 5 square centimeters; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the spacing of the apertures to optimize the process by controlling the volume and velocity of air through the work piece through the density of hole outlets including one per 5 square centimeters.



***Claim Objections***

8. Claim 12 is objected to because of the following informalities: Claim 12, dependent on claim 3, recites the limitation of "the circumferential extending hot air vents" in the first and second lines of the claim. There is insufficient antecedent basis for this limitation as "the circumferential extending hot air vents" are introduced in claim 4 upon which claim 12 is not dependent. Appropriate correction is required.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GALEN HAUTH whose telephone number is (571)270-5516. The examiner can normally be reached on Monday to Thursday 8:30am-5:00pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571)272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GHH/

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1791